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Application No.: 10/025,636

Docket No.: JCLA7952

REMARKS**Present Status of the Application**

Claims 1-18 are presented in the present application. The Office Action allowed claims 5, 6, 11, 12, 17 and 18. Also, the Office Action rejected claims 1, 2, 7, 8, 13 and 14. Further, the Office Action objected claims 3, 4, 9, 10, 15 and 16. Specifically, the Office Action rejected claims 1, 2, 7, 8, 13 and 14 under 35 U.S.C. 103(a) as being unpatentable over Cota-Robles (U.S. 6,631,429) in view of Beladi (U.S. 5,699,389), and further in view of Ichikawa (EP 1009125 A2). The Office Action objected claims 3, 4, 9, 10, 15 and 16 as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants have amended claims 1, 3, 4, 7, 9, 10, 13, 15 and 16. Amendments made for claims 1, 7 and 13 are based on FIGs. 3-6 and related description, therefore, no new matter is added therein. After entry of the foregoing amendments, claims 1-18 remain pending in the present application, and reconsideration of claims 1, 2, 7, 8, 13 and 14 is respectfully requested.

Discussion of Office Action Objections

The Office Action objected claims 3, 4, 9, 10, 15 and 16 as being dependent upon a rejected base claim. Applicants have amended those claims to be independent claims including all of the limitations of the base claim. Accordingly, claims 3, 4, 9, 10, 15 and 16 should be allowed.

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Discussion of Office Action Rejections

The Office Action rejected claims 1, 2, 7, 8, 13 and 14 under 35 U.S.C. 103(a) as being unpatentable over Cota-Robles in view of Beladi, and further in view of Ichikawa. Applicants respectfully traverse the rejections for at least the reasons set forth below.

The examiner is picking and choosing-impermissible hindsight. In *In re Fritch*, 972 F. 2d 1260, 1266, 23 USPQ2d 1780 (Fed. Cir 1992), the Federal circuit stated, "It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior so that the claimed invention is rendered obvious." In *re Gorman*, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). This court has previously stated that "one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." (quoting *In re Fine*, 837 F.2d at 1075, 5USPQ2d at 1600).

It is the Applicant's belief that the present rejection fits the Federal Circuit's description of an impermissible rejection under §103. The Examiner has simply listed certain elements of the present invention and the located isolated disclosures of those components.

Even the cited references are combined, combination of Cota-Robles, Beladi and Ichikawa does not disclose, teach or suggest the feature of "wherein, whether to process the underflow operation is determined by relative positions between the underflow circulation center point and the leading edge sampling phases" as claimed in claims 1 and 7, and the feature of "wherein, whether to process the overflow operation is determined by relative positions

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between the overflow circulation center point and the leading edge sampling phases" as claimed in claims 1 and 13.

Specifically, Cota-Robles failed to disclose to determine whether to process the underflow operation or not by observing phase shift of the leading edge sampling phases. In other words, Cota-Robles did not disclose that when phase shift of two leading edge sampling phases of neighboring data covers the underflow circulation center point, an underflow operation is performed. The feature is disclosed in the present application and is claimed in the amended claims 1 and 7 as "wherein, whether to process the underflow operation is determined by relative positions between the underflow circulation center point and the leading edge sampling phases". Even combined with Beladi and Ichikawa, the feature is not disclosed, taught or suggested. Accordingly, claims 1 and 7 are patentable over Cota-Robles in view of Beladi, and further in view of Ichikawa.

Further, Cota-Robles failed to disclose to determine whether to process the overflow operation or not by observing phase shift of the leading edge sampling phases. In other words, Cota-Robles did not disclose that when phase shift of two leading edge sampling phases of neighboring data covers the overflow circulation center point, an overflow operation is performed. The feature is disclosed in the present application and is claimed in the amended claims 1 and 13 as "wherein, whether to process the overflow operation is determined by relative positions between the underflow circulation center point and the leading edge sampling phases". Even combined with Beladi and Ichikawa, the feature is not disclosed, taught or suggested.

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Accordingly, claims 1 and 13 are patentable over Cota-Robles in view of Beladi, and further in view of Ichikawa.

Moreover, because the present invention is able to compensate properly when the underflow and the overflow happen, to ensure the bit number of the data received by the receiver is the same as the physical data, the underflow and the overflow problems are solved. With the disadvantage, the present invention is used in Fradays's USB controller. Fraday's USB IP has attained commercial success.

Accordingly, claims 1, 7 and 13 are patentable over Cota-Robles in view of Beladi, and further in view of Ichikawa. Claims 2, 8 and 14 are patentable over Cota-Robles in view of Beladi, and further in view of Ichikawa as a matter of law since their dependent claims are patentable over the citations.

For at least the foregoing reasons, Applicant respectfully submits that claims 1-4, 7-10 and 13-16 patently define over the prior art references, and should be allowed.

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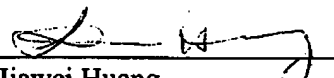
CONCLUSION

Applicant respectfully thanks for allowance of claims 5, 6, 11, 12, 17 and 18. Further, for at least the foregoing reasons, it is believed that the pending claims 1-4, 7-10 and 13-16 are in proper condition for allowance. If the Examiner believes that a telephone conference would expedite the examination of the above-identified patent application, the Examiner is invited to call the undersigned.

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4 Venture, Suite 250
Irvine, CA 92618
Tel.: (949) 660-0761
Fax: (949)-660-0809

Respectfully submitted,
J.C. PATENTS


Jiawei Huang
Registration No. 43,330